

March 23, 2006

Office of PCT Legal Administration  
**Attention: CHARLES PEARSON**  
P.O. Box 1450  
Alexandria, VA 22313-1450

**VIA FACSIMILE:** 571-273-0459

Re: Ari GRIFFNER  
U.S. Application No. 10/534,467  
Filed May 11, 2005  
International Appln. No. PCT/AT03/00314  
Filed October 16, 2003  
Attorney's File Ref.: 4301-1138

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Melody Douglas

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PATENT  
4301-1138

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Ari GRIFFNER

Conf. 7013

Application No. 10/534,467

(PCT/AT03/00314)

Int. Filing Date: 16 October 2003

Office of PCT Legal Administration  
Attention: CHARLES PEARSON

FOR: BUILDING MADE OF WALL HOLLOW HEATED ELEMENTS

**RENEWED REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.181**

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

March 23, 2006

Sir:

This replies to the Communication of 13 March 2006, in which the Office of PCT Legal Administration concludes that the declaration filed on 22 December 2005 does not sufficiently identify the specification to which it is directed.

It is once again respectfully submitted that the previously filed declaration of 22 December 2005, contains an acceptable combination of information to identify the specification to which it is directed, and must be accepted as complying with the identification requirement of 37 CFR 1.63(b)(1).

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Appln. No. 10/534,467

Submitted herewith is a copy of an O.G. notice issued on 15 August 1995, which clearly states that the following combinations of information supplied in a declaration filed after the filing date of the application are acceptable as minimums for identifying the specification, and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63. The O.G. notice goes on to list at item (3): the name of the inventor(s), and the attorney docket number which was on the specification as filed; and at item (6): the name of the inventor(s), the title of the invention which was on the specification as filed, and accompanied by a cover letter, which accurately identifies the application for which it was intended by providing the application number, or the serial number and filing date. In addition, item (6) states that absent any statement to the contrary, it will be presumed that the application filed in the USPTO is the application which the inventor executed by signing the declaration. The changes announced in the O.G. Notice by the Deputy Assistant Commissioner were shortly thereafter incorporated in the MPEP, and now appear at Section 602.

In this case, the declaration which accompanied the response to a Notification to File Missing Requirements filed on 22 December 2005, included the name of the inventor, the title of the invention which was on the specification as filed, and was

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accompanied by a cover letter accurately identifying the application serial number and filing date. In addition, the declaration contained the attorney docket number 4301-1138 on the upper right hand corner, which docket number was also present on the International stage transmittal (PTO 1390), which accompanied the specification papers.

Thus, while the declaration of record contained a typographical error in the PCT number, it nevertheless complies with at least item (E) of Section 602 of the MPEP, which appears on Page 600-34, and consequently must be accepted as complying with the identification requirement of 37 CFR 1.63, as promulgated by the O.G. notice.

The MPEP is unequivocally clear in this regard, as it plainly states that compliance with any one of the acceptable minimum combinations of information will be accepted. The undersigned attorney had checked with a Senior Legal Advisor of the Office of Petitions and was informed that such a declaration must be accepted. It is not readily apparent why the Office of PCT Legal Administration arbitrarily chooses to apply a different standard than that applied by the Office of Petitions and set forth in the MPEP.

The USPTO communication of 13 March 2006 apparently argues that the incorrect PCT number provided in the declaration "added to the confusion as to applicant's intentions," and somehow

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magically transformed an otherwise acceptable combination of information to be "unacceptable" for identifying the specification to which, it is directed.

This argument is untenable and in sharp conflict with the intent of the O.G. Notice from the Deputy Assistant Commissioner, which was to liberalize the identification requirement in a declaration by setting forth a number of alternative acceptable minimum combinations of information.

In addition, the combination of information provided in the declaration cannot constitute a variance of the guidelines set forth in the MPEP, as advanced in the USPTO communication, since such combination is clearly listed as one of the alternative acceptable ones.

In view of the above, it is respectfully submitted that the previously filed declaration of 22 December 2005 fully meets the requirements of 37 CFR 1.63 and 1.497. Reconsideration and a prompt finding that such declaration is acceptable are earnestly solicited.

Respectfully submitted,

YOUNG & THOMPSON

*Benoit Castel*

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Benoit Castel, Reg. No. 35,041  
745 South 23<sup>rd</sup> Street  
Arlington, VA 22202  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

BC/msd

13 MAR 2006



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Commissioner for Patents  
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Alexandria, VA 22313-1450  
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Young & Thompson  
745 South 23<sup>rd</sup> Street  
Arlington, VA 22202

In re Application of :  
GRIFFNER :  
Application No.: 10/534,467 :  
PCT No.: PCT/AT03/00314 :  
Int. Filing Date: 16 October 2003 :  
Priority Date: 11 November 2002 :  
Attorney Docket No.: 4301-1138 :  
For: BUILDING MADE OF WALL HALLOW :  
HEATED ELEMENTS :

## COMMUNICATION

This communication is in response to the applicant's "Response to Notification of Defective Response" filed 21 February 2006 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 16 October 2003, applicant filed international application PCT/AT03/00314, which claimed priority of an earlier application filed 11 November 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 May 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 11 May 2005.

On 11 May 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an Information Disclosure Statement and an Application Data Sheet.

On 24 October 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. In addition, applicant was informed of the need to provide an English translation of the international application. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 22 December 2005, applicant responded with an English translation of the

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international application and a combined declaration and power of attorney executed by the sole inventor. The international application number on the filed declaration was listed as PCT/AT2003/000315.

On 23 January 2006, applicant was mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the filed declaration was defective as it identified the wrong PCT application. Applicant was afforded one month from the mailing of the Form PCT/DO/EO/916 or the amount of extendable time from the mail date of the Form PCT/DO/EO/905 to file a proper reply.

On 21 February 2006, applicant filed the present response arguing that the papers filed on 22 December 2005 provided sufficient information for the declaration to comply with 37 CFR 1.63.

### DISCUSSION

Applicant concedes that the declaration filed 22 December 2005 contained a typographical error in the PCT number. Notwithstanding that error, applicant argues that the document complies with the identification requirement of 37 CFR 1.63(b)(1). Specifically, applicant cites Section 602 of the Manual of Patent Examining Procedure (MPEP) as support in the contention that the declaration contained the title of the invention which was on the specification, the declaration was accompanied by a cover letter accurately identifying the application serial number and filing date and the declaration contained the attorney docket number which appeared on the originally filed transmittal letter. However, Section 602 does not apply to the current situation. Section 602 provides a combination of information which is considered as acceptable minimums for identifying the specification. In the present case, although incorrect, a specification was identified. The additional information described in applicant's present response merely added to the confusion as to applicant's intentions.

Section 602 further states that:

Any variance from the above guidelines will only be considered upon the filing of a petition for waiver of the rules under 37 CFR 1.183 accompanied by a petition fee ( 37 CFR 1.17(f)).

Further an oath or declaration attached to a cover letter referencing an incorrect application may not become associated with the correct application and, therefore, could result in the abandonment of the correct application.


Thus, it is clear that Section 602 is not meant to provide an avenue for relief where the filed declaration lists an incorrect application number and the accompanying documents contain conflicting information as to the actual specification identified.

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CONCLUSION

Applicant is advised that a compliant oath or declaration of the inventor in response to the "Notification of Missing Requirements" (Form PCT/DO/EO/905) mailed 24 October 2005 has not been filed and that the extendable time period for responding continues to run. Failure to timely provide a compliant oath or declaration of the inventor will result in the application becoming abandoned as to the National stage in the United States.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294  
Fax: (571) 273-0459



Information in Oath/Declaration - Oath Date: 15 August 1995

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Information in Oath/Declaration  
Necessary to Identify the Specification  
for an Application filed under 35 USC 111  
in Accordance with 37 CFR 1.63

This notice supersedes the previous notice published at 1035 Off. Gaz. Pat. Office 3 on September 12, 1983, and is intended to make it easier for an applicant(s) to comply with the identification requirement of 37 CFR 1.63.

37 CFR 1.63 requires that an oath or declaration identify the specification to which it is directed. The declaration form suggested by the Office includes spaces for filling in the names of the inventors, title of invention, application number, filing date, foreign priority application information and United States priority application information. While this information should be provided, it is not essential that all of these spaces be filled in order to adequately identify the specification in compliance with 37 CFR 1.63(a)(2).

The following combinations of information supplied in an oath or declaration filed on the application filing date with a specification are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63:

- (1) name of inventor(s), and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration on filing;
- (2) name of inventor(s), and attorney docket number which was on the specification as filed; or
- (3) name of inventor(s), and title which was on the specification as filed.

Filing dates are now granted on applications filed without an oath or declaration in compliance with 37 CFR 1.63, the oath or declaration being filed later with a surcharge. The following combinations of information supplied in an oath or declaration filed after the filing date are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63:

- (1) name of inventor(s), and application number (consisting of the series code and the serial number; e.g., 08/123,456);
- (2) name of inventor(s), serial number and filing date;
- (3) name of inventor(s) and attorney docket number which was on the specification as filed;
- (4) name of inventor(s), title which was on the specification as filed and filing date;
- (5) name of inventor(s), title which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or
- (6) name of inventor(s), title which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number (consisting of the series code and the serial number; e.g., 08/123,456), or serial number and filing date. Absent any statement(s) to the contrary, it will be presumed that the application filed in the PTO is the application which the inventor(s) executed by signing the oath or declaration.

Any specification that is filed attached to an oath or declaration on a date later than the application filing date will not be compared with the specification submitted on filing. Absent any statement(s) to the contrary, the "attached" specification will be presumed to be a copy of the specification and any amendments thereto which were filed in the Office in order to obtain a filing date for the application.

Any variance from the above guidelines will only be considered upon the filing of a petition for waiver of the rules under 37 CFR 1.183 accompanied by a petition fee (37 CFR 1.17(h)).

**Information in Oath/Declaration - OG Date: 15 August 1995**

Further, an oath or declaration attached to a cover letter referencing an incorrect application may not become associated with the correct application and, therefore, could result in the abandonment of the correct application.

Supplemental oaths or declarations in accordance with 37 CFR 1.67 will be required in applications in which the oaths or declarations are not in compliance with the other requirements of 37 CFR 1.63 but contain sufficient information to identify the specifications to which they apply as detailed above.

A copy, such as a photocopy or facsimile transmission, of an originally executed oath or declaration is acceptable and may be filed. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Patent and Trademark Office may require submission of the original. See 37 CFR 1.4(d)(2).

See MPEP 1896 for the identification requirements for a declaration filed in a U.S. national stage application filed under 35 USC 371.

These changes will appear in MPEP 601.01 in the next revision of the Manual.

July 13, 1995

STEPHIN G. KUNIN  
Deputy Assistant Commissioner  
for Patent Policy and Projects

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